

Remarks

Claims 1-8 are pending and stand rejected as obvious under 35 U.S.C. §103 based on the combination Kurschat and Malick. Accompanying this response is a Request for Continued Examination (RCE).

Claim 1 is directed to a method for governing motion of a combination of a dynamically balanced transporter which in part requires: “a.) coupling the carrier to the dynamically balanced transporter with a pivot, the pivot characterized by a pivot axis; b.) tilting the transporter in a direction of desired motion; and c.) governing motion of the combination of transporter and carrier in response to the tilt of the transporter.” Such an arrangement is not taught or suggested by the prior art.

In particular, to combine Kurschat and Malick would defeat the essential purpose of Malick and, therefore, the combination cannot be “suggested” by either reference. Malick is directed to a powered unicycle, which applicants do not concede is “a dynamically stabilized transporter.” And as is well known in the art, a unicycle is steered by the user leaning such that the center of gravity of the unicycle creates a torque with respect the point of ground contact of the single wheel of the unicycle. Attaching the trailer (10) disclosed in Kurschat to the unicycle disclosed in Malick would defeat this. That is, adding a carrier to the unicycle of Malick would render Malick unsatisfactory for its intended purpose – the unicycle would simply not function as a unicycle. It is well established law that if a modification to a prior art renders the prior art unsatisfactory for its intended purpose the modification cannot be suggested. MPEP §2143.01 (“THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE”) (capitals in original). The basis for

this principle is the decision of the Federal Circuit in In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984).

Furthermore, the MPEP goes on to state that "THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE." Id. As discussed above, adding a trailer to a unicycle would change the principle operation of a unicycle. The combination would not be a unicycle at all but, rather, a tricycle (the trailer in Kurschat has at least two wheel). It goes without saying that the principle of operation of a tricycle is vastly different than that of a unicycle.

Accordingly, Applicants respectfully assert that, under well established law, the combination of Kurschat and Malick in not suggested and does not render the claimed invention obvious. As such, the rejection of claims 1-8 based on the combination of Kurschat and Malick is improper and should be withdrawn.

The present application makes clear that successfully attaching a trailer carrier to a dynamically stabilized transporter involves understanding and addressing multiple issues and interactions which go well beyond simply hooking part A onto part B. For example, on page 1, lines 20-23, the present application describes the problems arising from extraneous nonlinear torques presented by coupling a trailer to a dynamically stabilized transporter "in an arbitrary manner" and which "would present an obstacle to stable control of the transporter." Neither Kurschat nor Malick recognizes such an issue, and neither provides any teaching or suggestion to one of ordinary skill to overcome the problem. And neither reference suggests an approach for overcoming the effects of such extraneous nonlinear torques that can be created by simple coupling of a trailer to a dynamically balanced transporter such as the solution provided in the

detailed description of the present application starting on page 9, at line 11, which explains that “any component of force exerted by the carrier on the transporter that is transverse to the vertical direction must be minimized or particularly accounted for the control law.” Continuing on from that point in the specification, the present application then describes one specific arrangement to satisfy such design constraints, which once again, are entirely unrecognized by either Kurschat or Malick.

Thus, neither Kurschat nor Malick provide an enabling disclosure that would allow one of ordinary skill to couple a trailer carrier to a dynamically stabilized transporter as required by claim 1. Accordingly, the combination of those two references fails to make a *prima facie* case of obviousness, and claim 1 is allowable. *See MPEP 2121.01; Elan Pharm., Inc. v. Mayo Foundation for Medical and Education Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003); *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985). Claims 2-8 depend from claim 1 and are allowable for the same reasons.

Conclusion

Applicants believe that no extension of time is required; however, this conditional petition is made to provide for the possibility that the applicants have inadvertently overlooked the need for an extension of time. If any additional fees are required for the timely consideration of this application, please charge deposit account number 19-4972.

It is submitted that all the claim rejections have been addressed and that all of the pending claims are now in a condition for allowance. Reconsideration of the application and issuance of a notice of allowance are respectfully requested. If the Examiner believes, after this amendment,

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that the application is not in condition for allowance, the Examiner is invited to call applicants' attorney at the telephone number listed below.

Respectfully submitted,



Jay Sandvos
Registration No. 43,900
Attorney for Applicants

BROMBERG & SUNSTEIN LLP
125 Summer Street
Boston, MA 02110-1618
Tel: (617) 443-9292
Fax: (617) 443-0004
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